

Remarks

The non-final Office Action dated April 10, 2009 notes an objection to claims 1-20 due to informalities and the following rejections: claims 1-20 stand rejected under 35 U.S.C. § 112(2); claims 1-20 stand rejected under 35 U.S.C. § 103(a) over Hennessy (“Computer Organization and Design: The Hardware/Software Interface”) in view of Colwell (U.S. Patent No. 5,604,878). Applicant traverses the rejection and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses the objections and § 112(2) rejections because explicit antecedent basis is not required. *See, e.g.*, M.P.E.P. § 2173.05(e). The objections and § 112(2) rejections are improper because they are predicated on the erroneous assertion that explicit word for word antecedent basis is required. Applicant respectfully submits that the claims contain sufficient antecedent basis for each of the various terms identified by the Office Action. Notwithstanding, to facilitate prosecution, Applicant has amended various claims in a manner consistent with that suggested by the Office Action. Applicant believes that these amendments are not necessary for patentability and further, that the scope of the claims has not changed. In view of these amendments, Applicant believes that the objections and § 112(2) rejections are no longer applicable and requests that they be withdrawn.

Applicant respectfully traverses the § 103 rejection because the Office Action’s proposed modification of the Hennessy reference undermines the operation of Hennessy. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (Hennessy) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). In this instance, the Office Action proposes to modify the Hennessy reference such that MUX 61 and control logic 62 of the ‘878 reference (*see* Figure 3) are used to bypass MEM/WB stage of Hennessy’s

pipelined datapath (*see* Figure 6.25). However, as asserted by the Office Action, Hennessy is directed to a synchronous pipeline processor that is controlled by a clock signal. The Hennessy reference requires MEM/WB to ensure synchronization of the data being processed by the pipeline. As such, bypassing MEM/WB stage (asserted by the Office Action to be a latch) would result in the corruption of the data being processed by Hennessy's synchronous pipeline processor. Accordingly, the Office Action's proposed modification would render Hennessy inoperable. Thus, the Hennessy reference teaches away from the Office Action's proposed modification and there is no motivation for the skilled artisan to modify Hennessy in such a manner.

Moreover, the Office Action implicitly acknowledges that the proposed combination does not correspond to the claimed invention. For example, the claimed invention requires that the latch is held open for the generated pipeline data to propagate through the latch in the reduced mode. The Office Action's proposed modification results in the MEM/WB stage (*i.e.*, the asserted latch) being bypassed in the asserted reduced mode (*see, e.g.*, page 14 of the instant Office Action). Thus, pipeline data in the proposed combination does not propagate through the MEM/WB stage in the reduced mode, as required by the claimed invention. Should the Office Action attempt to assert that MUX 61 somehow corresponds to the claimed latch, such an assertion would be improper because the proposed combination results in the MUX 61 being located at the end of Hennessy's synchronous pipeline processor. Thus, MUX 61 would not be positioned between two pipeline stages as is the claimed latch.

In view of the above, the § 103 rejection is improper and Applicant requests that it be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068 (or the undersigned).

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